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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20

Application Number: 09/363,013
Filing Date: July 29, 1999
Appellant(s): SCHEFEE ET AL.

Bryan H. Davidson
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 3/12/01.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existance of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 15-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,700,393 Mueller 10-1972

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-20 are rejected under 35 U.S.C. §103(a). This rejection is set forth in prior Office Action, Paper No. 14.

(11) Response to Argument

Applicant is arguing that his invention is directed to a monopropellant and the prior art is directed to a bi-propellant, claiming that this is a critical important difference. Mueller discloses in Table 1 the use of hydrogen peroxide 70%/w as the oxidizer and ethyl alcohol as the fuel with the weight percent disclosed in the third column of Table 1. But the mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable (*In re Zierden* (CCPA) 162 USPQ 102). Terms merely setting forth intended use for, or a property inherent in, an otherwise old composition do not differentiate the claimed composition from those known to the prior art (*In re Pearson* (CCPA) 181 USPQ 641). Hydrogen peroxide is well known to be used in monopropellant and bi-propellant systems and Mueller clearly establish that the composition is notoriously well known in the art. Since claims 15-19 stand or fall together, looking at claim 15 the 103 rejection is based on the lack of novelty in the claimed subject matter, e.g., as evidenced by a complete disclosure of the propellant in the prior art (Table 1), which evidence is the "ultimate or epitome of obviousness". *In re Kalm*, 54 CCPA 1466, 1470, 378 F. 2d 959,962, 154 USPQ 10, 12 (1967).

Regarding claim 20, if necessary, it would be obvious to add more water to the composition in order to dilute more of the hydrogen peroxide and since it has been held that

where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine experimentation in the art (*In re Aller* 105 USPQ 233).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conf: EM

CJ

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GLS
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